OIPE IAP97 AUG 08 2007 PATENT & TRADEMARK OFFICE

Docket No.: M4065.0858/P858
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Michael Kaplinsky

Application No.: 09/209,982 | Confirmation No.: 6236

Filed: December 9, 1998 | Art Unit: 2622

For: COLOR CORRECTION OF MULTIPLE COLORS USING A CALIBRATED TECHNIQUE | Examiner: J.M. Villecco

APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed pursuant to 37 C.F.R. § 41.41 and is responsive to the Examiner's Answer mailed June 8, 2007 and the Supplemental Examiner's Answer mailed July 26, 2007 in connection with the appeal from the final rejection of claims 1, 3-9, 11-13, 16, 17, 21-26 in the above-identified U.S. patent application. An Oral Hearing is not requested.

I. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 19 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 2, 10, 14, 15 and 18-20
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1, 3-9, 11-13, 16, 17, 21-26
4. Claims allowed: None
5. Claims rejected: 1, 3-9, 11-13, 16, 17 and 21-26

C. Claims On Appeal

The claims on appeal are claims 1, 3-9, 11-13, 16, 17 and 21-26.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. The rejection of claims 1, 4-9, 11-13, 16, 17 and 21-26 under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent No. 6,320,668) ("Kim") in view of Yamaguchi (Japanese Publication No. 02-074367 A) ("Yamaguchi").

B. The rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over Kim and Yamaguchi and further in view of Endo (U.S. Patent No. 6,256,062) ("Endo").

III. ARGUMENT

Although the Examiner's Answer does not raise any new grounds for rejection, Appellant writes briefly here to respond to the Examiner's additional remarks regarding Appellant's arguments in the Appeal Brief.

A. CLAIMS 1, 4-9, 11-13, 16, 17 and 21-26 ARE PATENTABLE OVER KIM IN VIEW OF YAMAGUCHI (GROUND OF REJECTION A).

1. The combination of Kim and Yamaguchi does not teach or suggest all limitations of the claims and one skilled in the art would not have been motivated to combine the teachings of Kim and Yamaguchi absent improper hindsight provided by the application.

Each of the independent claims recites applying a weight factor to an error measure or using a weighted error measure to correct a color image, as discussed in more detail in the Appeal Brief at pages 10-15. The Examiner's Answer, admits, at page 11, that neither Kim nor Yamaguchi "specifically discloses applying a weight factor to the error measure of all of the known reference colors." The Examiner states that "Kim discloses all of the limitations of the claims except for weighting the error measure." Examiner's Answer at page 11. Appellant first notes that the Appeal Brief does not concede that this is true, as suggested by the Examiner at page 11. Appellant argues in the Appeal Brief that the claims are allowable "for at least this reason," and does not concede that the rest of the claim limitations are disclosed by Kim.

Appellant further notes that the Examiner goes on to state that "it is well known in the art to weight certain colors more than others to emphasize them." Examiner's Answer at page 11. Even if this is true, which Appellant does not concede, the limitations of the claims would not have been obvious in view of Kim and Yamaguchi. The Examiner's Answer merely states that "one of ordinary skill in the art would have found it obvious to weight those error measures based on the teachings of Yamaguchi, which broadly discloses applying weights to certain colors." Examiner's Answer at page 11.

The Supreme Court recently held in *KSR Int'l Co. v. Teleflex Inc.* that "the [Graham] factors continue to define the inquiry that controls" a finding of obviousness and reiterated that a "patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." 127 S. Ct. 1727, 1734 (U.S. 2007). The Graham factors include determining the scope and content of the prior art, ascertaining differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

Appellant submits that the Examiner has not properly shown that the Appellant's claims would have been obvious by conducting an examination of the Graham factors. "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case." M.P.E.P. § 2141. Instead, as evidence that Kim and Yamaguchi may be properly combined and that the Appellant's claims are obvious in light of these references, the Examiner merely states that it would be obvious "that by emphasizing certain colors more than others, a high quality image can be generated." Examiner's Answer at page 12. This statement is not an adequate substitution for an analysis of the Graham factors and does not show obviousness.

The claimed invention determines a color correction matrix which is used to correct the colors displayed on an image rendering device, such as e.g., a printer, display or monitor. In creating the color correction matrix, certain colors are weighted based on their subjective importance. The weighting of the claimed invention is advantageous because both the color correction and white balance are built-in with the color correction matrix and therefore, the white balance does not have to be separately performed on the image.

As discussed in the Appeal Brief at page 11, for example, Yamaguchi does not suggest weighting the colors in the manner claimed. The colors in Yamaguchi are "weighted" only by virtue of the fact that there are more "copies" of these colors in the color sample. The claimed invention weights the colors in a very different manner, by applying a weight factor to an error measure before creating the color correction matrix.

The conclusory statement provided by the Examiner is not enough to maintain a finding that the Appellant's claims are obvious. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006). In light of the holding of *KSR* and in light of the lack of any convincing argument as to the obviousness of the Appellant's claims, Appellant respectfully submits that the cited combination

does not teach or suggest all limitations of the claims, that the rejection is based improperly on hindsight and that the rejection should be reversed.

B. CLAIM 3 IS PATENTABLE OVER KIM IN VIEW OF YAMAGUCHI AND FURTHER IN VIEW OF ENDO (GROUND OF REJECTION B).

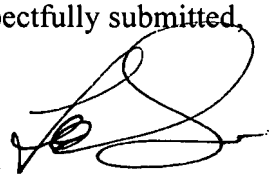
As stated in the Appeal Brief at page 19, Endo does not remedy the deficiencies of the Kim/Yamaguchi combination as to claim 1 (from which claim 3 depends). Therefore, claim 3 is allowable and the rejection should be reversed.

IV. CONCLUSION

For the foregoing reasons, Appellant respectfully submits that the claimed invention is not rendered obvious by the cited combination of references, and reversal of the final grounds of rejection is respectfully solicited.

Dated: August 8, 2007

Respectfully submitted,



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